



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,592	06/25/2001	Alex D. Starkovich	42390P10394	2119

8791 7590 10/18/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

RAMPURIA, SHARAD K

ART UNIT PAPER NUMBER

2617

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,592

Applicant(s)

STARKOVICH ET AL.

Examiner

Sharad Rampuria

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

I. The Art Unit location of this application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Disposition of the claims

II. The current office-action is in response to the remarks filed on 07/25/2006. Accordingly, Claims 1-28 are pending for further examination as follows:

Claim Rejections - 35 USC § 102

III. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 9, 11-14, 18-21, 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Pradhan et al. [US 6968178].

As per claim 1, Pradhan teaches:

A method of transmitting a message from a portable communication device (10; Fig.1, Abstract) comprising:

Preparing the message to be transmitted, wherein preparing includes receiving a user-generated message; (Col.11; 40-63, Col.10; 34-41, Abstract)

Associating the message with a user-defined event to specify the conditions upon which transmission of the associated message should occur; (Col.11; 64-Col.12; 17, Abstract)

Transmitting the message from the portable communication device upon the occurrence of the user defined event. (Col.11; 64-Col.12; 17, Abstract).

Regarding Claim 2, Pradhan disclosed the method of claim 1, wherein transmitting the message includes transmitting the message from the portable communication device to a base station. (Col.11; 10-19)

Regarding Claim 3, Pradhan disclosed The method of claim 1, further comprising specifying the user defined event. (Col.11; 40-63, Abstract)

Regarding Claim 4, Pradhan disclosed The method of claim 3, wherein specifying the user defined event includes specifying the date and time for transmission of the message. (Col.11; 40-63, Abstract)

Regarding Claim 9, Pradhan disclosed The method of claim 1, further comprising compressing the message only when the portable communication device is coupled to a stable power supply. (Inherent; 10; Fig.1, Abstract)

Art Unit: 2617

Regarding Claim 11, Pradhan disclosed The method of claim 1, further comprising storing the message in memory in the portable communication device. (19a; fig.1; col.8; 58-67)

Regarding Claim 12, Pradhan disclosed The method of claim 11, wherein storing the message in memory includes storing the message in non-volatile memory. (19a; fig.1; col.8; 58-67)

As per claim 13, Pradhan teaches:

A method of transmitting a message to a portable communication device (10; Fig.1, Abstract) comprising:

Receiving a user-generated message; (Col.11; 40-63, Col.10; 34-41, Abstract)

Storing the message in memory; (19a; fig.1; col.8; 58-67)

Defining a transmission condition for when the message is to be transmitted the transmission condition being defined by the user; associating the message with the transmission condition; and transmitting the message from the portable communication device upon occurrence of the transmission condition. (Col.11; 40-Col.12; 17, Abstract)

Regarding Claim 14, Pradhan disclosed The method of claim 13, wherein defining a transmission condition includes defining a time when the message is to be transmitted. (Col.11; 40-63, Col.10; 34-41, Abstract).

Art Unit: 2617

Regarding Claim 18, Pradhan disclosed The method of claim 13, further comprising receiving the message with an antennae on the portable communication device. (12; fig.1, Col.8; 58-65)

As per claim 19, Pradhan teaches:

A portable communication device (10; Fig.1, Abstract) comprising:

A memory to store a message; (19a; fig.1; col.8; 58-67), the message being associated with a user-defined event; (Col.11; 40-63, Col.10; 34-41, Abstract)

A transmitter having an antennae to transmit the message; (12; fig.1, Col.8; 58-65) and

A processor, wherein the processor allows transmission of the message with the transmitter upon occurrence of a user defined event. (col.9; 20-30, Col.11; 40-Col.12; 17, Abstract)

Regarding Claim 20, Pradhan disclosed The portable communication device of claim 19, where in the processor is further adapted to monitor the operation of the portable communication device and determine if the user defined event has occurred. (Col.11; 40-63, Col.10; 34-41, Abstract)

Regarding Claim 21, Pradhan disclosed The portable communication device of claim 20, wherein the processor is further adapted to determine if a current time is substantially equal to a time specified as at least part of the user defined event. (Col.11; 40-63, Col.10; 34-41, Abstract).

Claims 24-28 are the An article comprising: a storage medium having stored thereon instructions, that, when executed by a computing platform, claim corresponding to device claims 19-21 respectively, and rejected under the same rationale set forth in connection with the rejection of claims 19-21 respectively, above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 & 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pradhan in view of Yach et al. (US 20020128036).

Regarding Claims 6, 8 Pradhan disclosed all the particulars of the claim except the user defined event includes specifying an acceptable transmission power level at which the message is to be sent. However, Yach teaches in an analogous art, that the method of claim 3, wherein specifying the user defined event includes specifying an acceptable transmission power level or distance at which the message is to be sent. (Pg.7; 0064) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event

Art Unit: 2617

includes specifying an acceptable transmission power level at which the message is to be sent in order provide transmission power control method in achieving the target.

Claims 5, 7, 15-17, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pradhan in view of Price et al. (US 20020082881).

Regarding Claims 5,17 Pradhan disclosed all the particulars of the claim except the user defined event includes specifying an acceptable cost level at which the message is to be sent. However, Price teaches in an analogous art, that the method of claims 3, 13 respectively, wherein specifying the user defined event includes specifying an acceptable cost level at which the message is to be sent. (Pgs.3-4; 0052) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable cost level at which the message is to be sent in order to provide complex pricing for plural electronic exchange transaction events such that individual events, accumulated events, cross product events and non-transactional events.

Regarding Claims 16, 23 Pradhan disclosed all the particulars of the claim except defining an acceptable quality of service level for when the message is to be transmitted. However, Price teaches in an analogous art, that the method of claims 13, 20 respectively, wherein defining a transmission condition includes defining an acceptable quality of service level for when the message is to be transmitted. (Pgs.3-4; 0052) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable quality of service level at which the message is to be

Art Unit: 2617

sent in order to provide information exchange with communication network based on user needs and network capacity.

Regarding Claims 7, 15, 22 Pradhan disclosed all the particulars of the claim except the user defined event includes specifying an acceptable security level at which the message is to be sent. However, Price teaches in an analogous art, that the method of claims 3, 13, 20 wherein specifying the user defined event includes specifying an acceptable security level at which the message is to be sent. (Pg.7; 0095) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the user defined event includes specifying an acceptable security level at which the message is to be sent in order to provides for secure delivery of user-selected data items from the host system to mobile device.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pradhan in view of Adams (US 6400814).

Regarding Claim 10, Pradhan disclosed all the particulars of the claim except transmitting the message includes wirelessly transmitting the message to a receiver and disabling a ringing function of the receiver. However, Adams teaches in an analogous art, that The method of claim 1, wherein transmitting the message includes wirelessly transmitting the message to a receiver and disabling a ringing function of the receiver. (col.4; 42-54) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include transmitting the

Art Unit: 2617

message includes wirelessly transmitting the message to a receiver and disabling a ringing function of the receiver in order to determine operational status thereof.

Response to Remarks

IV. Applicant's arguments filed on 07/25/2006 have been fully considered but they are not persuasive.

Relating to Claim 1:

In comeback to Applicant's allegation that **Pradhan** doesn't teach, "Associating the message with a user-defined event to specify the conditions upon which transmission of the associated message should occur; Transmitting the message from the portable communication device upon the occurrence of the user defined event." it is noted that the Examiner respectfully asserts that the cited art, is legally efficient for the purpose of rendering claim unpatentable. In particular, **Pradhan** supports the declaration as, the consumer telecommunications device having an advertisement filter provided with an allowable advertisement characteristics profile and the consumer device comparing the received advertisement characteristic profile with is filter profile and accepting advertisement which match its advertisement characteristics profile to an acceptable degree and rejecting advertisements whose characteristics profile does not match to an acceptable degree. (Please perceive Col.10; 20-Col.11; 2, Col.9; 31-38, Col.6; 52-65, Col.11; 64-Col.12; 17, Abstract), consequently, Pradhan reveal that a message can be transferred to the user based on the user's location which is filtered by user's preference, based on certain conditions. for ex. Price or availability of the products that can definitely read on the claimed

invention. At the same time as in support; “the examiner must give the broadest reasonable interpretation to all claims presented.” As stated in MPEP § 2111 - § 2111.01. Hence, it is believed that *Pradhan still teaches the claimed limitations*.

The above arguments also recites for the claims 13, 19, 24, consequently the response is the same explanation as set forth above with regard to claim 1.

Because the remaining claims depend directly/indirectly, from one of the independent claims discussed above, consequently the response is the same explanation as set forth above.

With the intention of that explanation, it is believed and as enlighten above, the refutation are sustained.

Conclusion

V. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Art Unit: 2617


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is (571) 272-7870.

The examiner can normally be reached on M-F. (8:30-5 EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or EBC@uspto.gov.


Sharad Rampuria
Patent Examiner
Art Unit 2617


GEORGE ENG
SUPERVISORY PATENT EXAMINER